

09/651,983  
Art Unit 3628  
9040.00

#### REMARKS

This Amendment is submitted in response to the Office Action mailed on February 10, 2005. Claims 1 - 9 are pending, rejected, and appealed. Claims 10 and 11 are added. No fee is due.

#### RESPONSE TO REJECTION OF CLAIMS 1 - 3

##### Summary of Response

Claim 1(d) states:

. . . without using communications from parties performing the replenishment, preparing one, or more, reports concerning the ATMs replenished that a report is generated

The PTO relies on Clark, column 6, lines 50 - 53, to show this. That Clark-passage states:

An updated ATM STATUS REPORT  
**based on the input data**  
is sent to the host computer in step 138.

Applicant points out that the "input data" of Clark is obtained from the technician performing the replenishment. That "input data" is described in column 6, line 46 et seq., and is punched in by the technician on keypad 27, within the ATM, in Clark's Figure 2. That "input data" indicates the type and number of bills replenished.

That is contrary to claim 1(d), which states that the report

09/651,983  
Art Unit 3628  
9040.00

is generated "without using communications from parties performing the replenishment."

#### **End Summary**

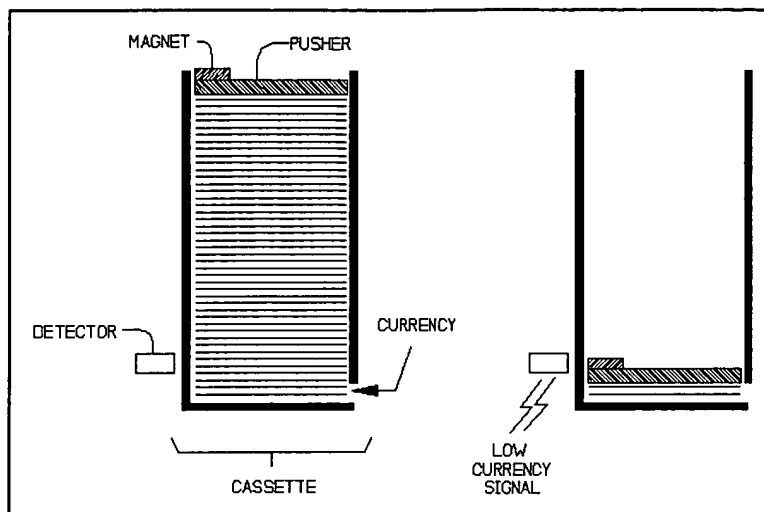
Claims 1 - 3 were rejected on grounds of anticipation, based on Clark.

#### **Clark Reference**

Clark indicates that, in ATMs, a magnet is commonly positioned on a "pusher" in a stack of currency held in a cassette. The cassette dispenses the currency to customers. As the currency is dispensed, the magnet will be lowered, since the stack of currency becomes shorter. Eventually, the magnet reaches a point where it actuates a reed switch, indicating that the cassette should be replenished. (Column 1, lines 16 - 28.)

Sketch 1, below, is a schematic of the situation.

09/651,983  
Art Unit 3628  
9040.00



Sketch 1

The DETECTOR in the Sketch corresponds to Clark's reed switch. When the stack of currency becomes sufficiently depleted, a LOW CURRENCY SIGNAL is issued by the DETECTOR, because the MAGNET has been moved adjacent the DETECTOR, and the DETECTOR detects the magnetic field.

Applicant here points out that the DETECTOR (ie, Clark's reed switch) is "mounted within the ATM." (Column 1, line 27.) Thus, when the CASSETTE is removed, the DETECTOR remains in place. This will be significant to claim 4, as discussed below.

Clark discusses this detection scheme in his Background. However, it is not clear whether (A) this type of detection is used in Clark's invention or (B) Clark is only pointing to the presence of this type of detection in his prior art.

09/651,983  
Art Unit 3628  
9040.00

The lack of clarity stems from the fact that Clark is not concerned with detection of low levels of currency. Instead, he is concerned with a particular problem caused by cassettes containing the low levels of currency. Clark states that those partially empty cassettes are transported to the bank owning the ATM. Clark states that this approach provides opportunities for theft of currency from the cassettes: technicians are in possession of partially empty cassettes, which contain money which can be stolen. (Column 1, lines 56 - 65.)

Clark's invention solves this problem, by eliminating transport of the partially empty cassettes, in a manner which will now be explained. (See column 7, top.)

Clark discusses a replenishment sequence.

- 1) A technician visits an ATM.
- 2) The technician punches in his ID data on the customer keypad. If the technician's ID is verified, the technician is allowed to place the ATM into "supervisory mode," wherein it will not respond to customers. (Column 5, lines 49 - 57.)
- 3) If the technician selects a "replenish" option, then the ATM generates a status report. This status report indicates the current contents of each cassette within

09/651,983  
Art Unit 3628  
9040.00

the ATM. (Column 5, line 66 - column 6, line 7.)

Applicant points out that this status report **IS NOT** printed if the technician **DOES NOT** select "replenish." (Figure 5, "NO" branch of decision block 126.)

4) The technician may select a "purge" operation, wherein partially empty cassettes are emptied into a storage device. (Column 6, line 8 et seq.) The now-purged, and empty, cassettes can be returned to the bank.

5) Whether or not "purge" is selected, the technician then replaces empty cassettes with full cassettes. The technician, using key pad 27 in Clark's Figure 2, which is inside the ATM (Column 3, lines 9 - 13), informs the "host computer" at the bank of the type and amount of bills replenished. (Column 6, lines 41 - 67.)

The "host computer" is informed by way of an ATM STATUS REPORT. (Column 6, lines 52, 53.)

09/651,983  
Art Unit 3628  
9040.00

## Application of Clark to Claims

### Claim 1

Claim 1 recites:

1. In connection with operation of a system of ATMs, each of which contains at least one computer, a method comprising the following steps:

- a) identifying low-stocked ATMs, which require replenishment of currency;
- b) causing replenishment of currency in low-stocked ATMs to occur;
- c) receiving replenishment signals from the replenished ATMs; and
- d) using the replenishment signals, **and without using communications from parties performing the replenishment**, preparing one, or more, reports concerning the ATMs replenished.

### Point 1

Applicant points out that the **highlighted** section of claim 1(d) is absent from Clark.

The PTO relies on Clark, column 6, lines 50 - 53, to show claims 1(c) and (d). That Clark-passage states:

An updated ATM STATUS REPORT  
**based on the input data**  
is sent to the host computer in step 138.

Applicant points out that the "input data" is obtained from the technician performing the replenishment. That "input data" is

09/651,983  
Art Unit 3628  
9040.00

described in column 6, line 46 et seq., and is punched in by the technician on keypad 27, within the ATM, in Clark's Figure 2. That "input data" indicates the type and number of bills replenished.

That is contrary to the **highlighted** section of claim 1(d), which is repeated here:

d) using the replenishment signals, **and without using communications from parties performing the replenishment**, preparing one, or more, reports concerning the ATMs replenished.

From another point of view, Clark discusses no mechanism or device which can generate the ATM STATUS REPORT automatically, and without the involvement of the technician. Plainly, input from the technician is required for this ATM STATUS REPORT, contrary to claim 1(d).

#### Point 2

Claim 1(c) recites "replenishment signals." The PTO relies on column 6, lines 50 - 53, to show the "replenishment signals."

However, that passage only shows data which is input **by the technician**. Claim 1(d) recites that the replenishment signals are used for preparing a report, "**without using communications from parties performing the replenishment.**"

Since the technician generates the replenishment signals

09/651,983  
Art Unit 3628  
9040.00

#### Claims 2 and 3

The preceding discussion applies to dependent claims 2 and 3.

#### **RESPONSE TO REJECTION OF CLAIM 4**

Claim 4 was rejected on grounds of obviousness, based on Clark. Claim 4 recites:

4. Method according to claim 3, wherein entry into an ATM by a burglar causes a replenishment signal to occur.

#### Comment on Claim 4

To explain claim 4, Applicant points out that, in one form of the Invention, the ATM is equipped with a burglar alarm. If the door of the ATM is opened, the burglar alarm notifies a central computer. However, the central computer knows when a technician is to service the ATM. If the burglar alarm goes off at that time, the central computer assumes that the technician opened the door, and not a burglar. The burglar-alarm-signal is treated as a "replenishment signal." If a replenishment signal occurs at other times, it is assumed to be caused by a burglar.

#### The Rejection

The Office Action presumes that a specific type of theft occurs in Clark, and that such a theft causes the LOW CURRENCY SIGNAL of Sketch 1, above, to occur. In these presumptions, the



09/651,983  
Art Unit 3628  
9040.00

Office Action purports to find claim 4 obvious, based on Clark.

However, several problems arise in the Office Action's approach.

#### PROBLEM 1

The specific type of theft has not been shown in the prior art, and other types of theft can **fail to result** in the LOW CURRENCY SIGNAL being issued.

For example, if the burglar removes only a handful of currency in Sketch 1, above, the MAGNET will not fall to a sufficiently low level to activate the DETECTOR.

As another example, it may be assumed that, if a burglar succeeds in gaining entry to an ATM, the burglar knows the basic operation of the ATM. The burglar can remove CURRENCY, and replace it with newspaper, to thereby prevent the MAGNET from actuating the DETECTOR.

As another example, the burglar can remove the PUSHER entirely, thereby preventing the MAGNET from actuating the DETECTOR, even if all the CURRENCY is removed.

As another example, the burglar can remove the entire CASSETTE. That does not cause the LOW CURRENCY SIGNAL to arise, because the MAGNET has been removed from proximity of the DETECTOR.

Therefore, the Office Action presumes a **specific type of theft** occurs in Clark. But other types of theft are possible, as just

09/651,983  
Art Unit 3628  
9040.00

explained.

The Office Action is arguing that its specific type of theft is "inherent" in Clark. MPEP § 2112 states:

EXAMINER MUST PROVIDE RATIONALE OR EVIDENCE  
TENDING TO SHOW INHERENCY.

In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teaching of the applied prior art.

No such "basis in fact and/or technical reasoning" have been shown.

#### PROBLEM 2

The type of theft on which the PTO relies has not been shown in the prior art. MPEP § 2143.03 states:

To establish prima facie obviousness . . . **all the claim limitations** must be taught or suggested by the prior art.

#### PROBLEM 3

The PTO's reading of claim 4 is inconsistent with common sense.

Parent claim 3 recites "replenishment signals." The Office Action, page 3, previously stated that those signals are generated

09/651,983  
Art Unit 3628  
9040.00

by the "operator [who] makes the replenishment." As explained above, the operator/technician uses keypad 27 in Clark's Figure 2 to issue these signals.

As to claim 4, it is highly unlikely that a thief would operate the keypad 27 in Clark's Figure 2, when he steals the currency. Why would the thief do this ?

Thus, as a matter of common sense, no "replenishment signals" as in parent claim 3 are issued when the thief steals the currency. As a minimum, no teaching as to why the thief would do that has been given. A teaching is required.

#### PROBLEM 4

The PTO's interpretation of claim 4 is contradictory to the parent claims.

As explained immediately above, parent claim 3 recites "replenishment signals," which are generated by the operator/technician.

But, in claim 4, the PTO asserts that (1) a thief induces the LOW CURRENCY SIGNAL of Sketch 1, above, and (2) the LOW CURRENCY SIGNAL shows the "replenishment signals" of claim 4.

The problem is that the PTO is reading "replenishment signal" in the parent claims on one signal in Clark, while reading "replenishment signal" in claim 4 on another signal.

"Replenishment signal" must be read consistently throughout.

09/651,983  
Art Unit 3628  
9040.00

#### PROBLEM 5

The LOW CURRENCY SIGNAL, which the PTO supposedly finds for claim 4, does not actually qualify as a "replenishment signal" as that term is used in the parent claims.

Parent claim 1(c) recites:

c) receiving replenishment signals from the replenished ATMs.

The LOW CURRENCY SIGNAL of Sketch 1 is not issued by a "replenished ATM." It is issued by an ATM **needing replenishment**.

Therefore, the "replenishment signal" of claim 4, which must correspond to the "replenishment signal" of the parent claims, cannot correspond to the LOW CURRENCY SIGNAL of Sketch 1, above.

#### RESPONSE TO REJECTION OF CLAIM 5

Claim 5 was rejected as obvious, based on Clark and Ross.

Claim 5 recites:

5. In the operation of a system of ATMs,  
a method comprising:

a) maintaining a security system within each ATM, which

i) detects entry into the ATM, and

ii) issues an entry signal in response;  
and

09/651,983  
Art Unit 3628  
9040.00

- b) scheduling replenishment of a group of ATMs during a time period; and
- c) when entry signals are received from ATMs within the group, during the time period, designating the corresponding ATMs as having been replenished in currency.

**Point 1**

Claim 5(c) states, in effect, "If you receive a burglar alarm from an ATM in the 'time period,' assume that the ATM is being replenished and not burglarized." That operation, or reasoning, is nowhere found in the references, even if combined.

**Point 2**

Claim 5 states that (1) "entry signals" are received from the "group," and (2) the ATMs in the "group" are then "designat[ed] . . . as having been replenished."

No "entry signals" from a "group" have been shown in the references.

No "designation" of the ATMs in the "group" has been shown in the references.

Thus, even if the references are combined, claim 5 is not found.

**Point 3**

Claim 5 recites a "system of ATMs." Ross is cited to show

09/651,983  
Art Unit 3628  
9040.00

that. However, he only shows a **single** ATM. This claim recitation is missing from the references, even if combined.

#### Point 4

The Office Action admits that Ross fails to show scheduling replenishing of a group of ATMs during a time period. This claim recitation is missing from the references, even if combined.

The Office Action then asserts that it is "obvious" to perform this type of scheduling. However, that assertion is a misapplication of the law of obviousness.

"Obviousness" is not a device to supply missing elements, which are not found in the prior art. MPEP § 2143.03 states:

To establish prima facie obviousness . . . **all the claim limitations** must be taught or suggested by the prior art.

Instead, "obviousness" allows the PTO, under certain circumstances, to combine elements **which are shown in the prior art**.

But if a claim element is absent from the prior art, "obviousness" does not provide a tool for curing that absence.

#### Point 5

Applicant submits that the reasoning of the Office Action is flawed.

09/651,983  
Art Unit 3628  
9040.00

The reasoning is that "If there exists a plurality of ATMs," then a group of them should be scheduled for a time period, because (1) more depleted ATMs are given priority and (2) conflicts in replenishment are avoided.

However, several problems exist in this reasoning.

#### Problem 1

One problem is that, as explained above, the premise of the rationale is hypothetical. No "plurality" of ATMs has been shown. The premise is that "If" a plurality exists.

A hypothetical does not qualify as prior art.

Stated another way, a plurality of ATMs is only found in Applicant's claims. The claims cannot be used as prior art.

#### Problem 2

The Office Action has not shown why the more-depleted ATMs should be scheduled in the "group."

In fact, it makes more sense to schedule ATMs which are geographically together.

Thus, the PTO's justification for the scheduling of the group appears to be based on Applicant's own claim, which is not allowed.

#### Problem 3

The PTO has not shown how avoidance of conflicts leads to the

09/651,983  
Art Unit 3628  
9040.00

scheduling of a "group." In fact, the opposite would seem to be the case.

Assume that 5 technicians replenish ATMs. A "group" of ATMs is scheduled for replenishment. How does that grouping prevent both technician 1 and 5 from replenishing the same ATM ?

In fact, if no "group" were created, "conflicts" would be avoided. That is, if no "group" is scheduled for a same time period, but instead each ATM is scheduled for a separate time, then "conflicts" are automatically avoided.

#### Problem 4

The PTO's reasoning pre-supposes the existence of a non-problem, namely, "conflicts." The PTO pre-supposes that, somehow, in the prior art, multiple technicians converge on the same ATM and mistakenly all try to replenish that ATM.

Applicant submits that this supposed "conflict" does not exist, and that utterly simple administrative expedients exist which prevent such "conflicts." For example, a single technician is assigned a collection of ATMs. Since the single technician can replenish only one ATM at a time, no conflicts exist.

Therefore, since it appears that the teaching for combining the references is directed toward eliminating a non-existent problem, Applicant requests that the problem be shown in the prior art.



09/651,983  
Art Unit 3628  
9040.00

#### Point 6

The teaching for combining the references (page 5, second-to-last paragraph) does not actually lead to the combination.

The goal of the teaching is to "provide the status . . . report of a replenished ATM." However, Clark, by himself, provides such status reports. There is no need to combine Clark with Ross to obtain those status reports.

Further, the stated advantage of such status reports is non-existent. The stated advantage is that the reports eliminate "unnecessary trips to replenish an already replenished ATM."

Applicant asks, suppose ATM X is replenished, and a status report is issued. However, ATM X is located next to a major league baseball park in New York, where the World Series is being played. ATM X is emptied of cash within 2 hours.

How did the status report eliminate "unnecessary trips to replenish an already replenished ATM" ?

Stated more generally, any need for replenishment will occur **after** the initial replenishment, and **after** the "status report" in question. How does the "status report" eliminate "unnecessary trips" which occur later ?

#### RESPONSE TO REJECTION OF CLAIMS 6, 7, and 9

These claims were rejected on grounds of obviousness, based

09/651,983  
Art Unit 3628  
9040.00

on Ross and Clark. Claim 6 recites:

6. (Original) A method of replenishing a plurality of ATMs, comprising the following steps:

- a) for each ATM, making an estimate of the amount of currency stored therein, without measuring the currency presently stored;
- b) using the estimates, identifying a subset of ATMs to be re-stocked with currency;
- c) for each ATM in the subset, preparing a packet of currency;
- d) transferring the packets to a courier;
- e) receiving one, or more, signals from each ATM, which indicate interaction with the ATM by a party other than a customer;
- f) recording
  - i) the times of receipt of the signals, and
  - ii) the identities of the ATMs issuing the respective signals; and
- g) ascertaining whether the signals were issued by an ATM within the subset and
  - i) if not, contacting a law enforcement agency;
  - ii) if so, adjusting the estimate of the currency stored within that ATM.

Applicant submits that, even if the references are combined, claim 6 is not attained. MPEP § 2143.03 states:

09/651,983  
Art Unit 3628  
9040.00

To establish prima facie obviousness . . . **all the claim limitations** must be taught or suggested by the prior art.

Example 1

For example, claim 6(b) recites

b) using the estimates, identifying a subset of ATMs to be re-stocked with currency.

The Office Action has shown (1) no "subsets" in the references, nor (2) the claimed identification of the subsets.

Example 2

As another example, claim 6(c) recites

c) for each ATM in the subset, preparing a packet of currency.

That has not been shown in the references.

The Office Action asserts that

The serviceman would need currency to re-stock these low-stocked ATMs and therefore a packet of currency must be prepared . . .

(Office Action, page 6, second paragraph.)

However, this assertion is not correct. A packet of currency for each ATM is not required for re-stocking the ATMs. The serviceman could be given a suitcase full of currency (a single

09/651,983  
Art Unit 3628  
9040.00

"packet" for all ATMs). When he arrives at each ATM, he determines the amount of money needed, and removes that much from the suitcase.

A "packet" for each ATM is not required.

#### Example 3

As another example, the transfer of the packets to the courier, as in claim 6(d), has not been shown in the references. In fact, the PTO's interpretation of the references implies the absence of claim 6(d).

Under the PTO's interpretation, the serviceman in Clark makes an estimate of the amount of currency needed by each ATM. That serviceman, according to the PTO, prepares the "packets." Thus, there is no "transfer" of the "packets" to that serviceman. He has them already.

Further, as explained above, no "packets" have been shown in Clark. Thus, no "packets" are present for "transfer."

#### Example 4

As another example, the Office Action admits that claim 6(f) is not found in Clark. To cure this defect, the Office Action asserts that it is "obvious" to perform the claimed "recording."

However, "obviousness" is not a tool to cure the absence of claim elements in the prior art. "Obviousness" is a legal test of

09/651,983  
Art Unit 3628  
9040.00

whether an invention is patentable, based on components identified in the prior art.

Stated another way, there is no legal standard for determining whether the (nonexistent) claim elements are "obvious." Under section 103, the standard is whether the claimed "subject matter as a whole" is "obvious," in view of the prior art, not whether that prior art (which the missing elements in question must be) is "obvious."

#### Example 5

As another example, the Office Action asserts that Ross shows "contacting a law enforcement agency in the event of an abnormality or malfunction." (Office Action, page 7, first full paragraph.)

That is not correct. In the cited passage of Ross, Ross states that an acoustic sensor is used to detect "forced entries by criminals into the safe 17." (Column 8, line 16.) If such is detected, then Ross issues a signal to the "remote service station 62." The latter notify the police. (Column 8, line 26.)

Thus, Ross does not teach contacting the police if a generalized abnormality or malfunction occurs. He teaches contacting the police if **ONE SPECIFIC EVENT** occurs, namely, forced entry into the safe.

In addition, even if Ross teaches what the Office Action asserts, that teaching does not correspond to the claim. Claim

09/651,983  
Art Unit 3628  
9040.00

6(g) recites ascertaining whether the signals were received from an ATM **in the "subset."** Those ATMs were scheduled to undergo replenishment. Ross's supposed calling-the-police if a malfunction occurs does not show ascertaining whether the signals were received from an ATM **in the subset.**

#### Example 6

As another example, claim 6(g) states that an estimate of the currency held by the replenished ATM is adjusted, because of the "signals." (That is, the signals are taken as indicating that the ATM has been replenished. Consequently, the amount of currency in the ATM is increased by the amount in the packet delivered to that ATM.)

That has not been shown in the references.

Further, the Office Action is being inconsistent. It treats the "warning signal" of Ross (column 8, line 25) as the "signals" of claim 6(g). But claim 6(g) states that the "signals" induce the adjustment of the "estimate," if they emanate from ATMs in the "subset."

Ross's signals do not induce the adjustment of the estimate, according to the Office Action. The Office Action states that adjustment of an estimate is done for a different reason. (Office Action, page 7, second full paragraph.) Thus, the Office Action has not shown that the "signals" induce the adjustment, as claim

09/651,983  
Art Unit 3628  
9040.00

6(g) recites.

In addition, Applicant submits that the PTO is giving an interpretation to Ross which is contrary to common sense, and to Ross's teachings. Ross overall states that a properly operating ATM produces certain sounds. Ross suggests using microphones to detect the sounds, and if abnormal sounds are detected, to issue a warning. Ross also suggests that a microphone can be used to detect intrusion into a safe, as discussed above.

Ross states that, when a technician services an ATM, the ATM is "shut down." (Column 1, lines 46 - 51.) Thus, it is reasonable to assume that his microphones are also shut down, including the microphoine monitoring the safe.

Therefore, no "warning signal" of column 8, line 25 would be issued when an ATM is replenished. Thus, the "signals" of claim 6(e) are not present in Ross, when replenishment occurs.

#### **Claim 7**

Claim 7 recites:

7. Method according to claim 6, wherein  
no person directly reports replenishment  
currency supply of any ATM.

Applicant points out that claim 7 is contrary to Clark. As explained above, input data of Clark is obtained from the technician performing the replenishment. That input data is

09/651,983  
Art Unit 3628  
9040.00

described in column 6, line 46 et seq., and is punched in by the technician on keypad 27, within the ATM, in Clark's Figure 2. That "input data" indicates the type and number of bills replenished, and is sent to a central agency.

That is contrary to claim 7, because, in Clark, a "person" makes the "report," contrary to claim 7.

#### Claim 9

Claim 9 depends from claim 7, and is seen as patentable for that reason.

#### Claim 8

Claim 8 was rejected as obvious, based on Clark.

Claim 8 recites "In the operation of a group of ATMs, a method comprising . . . ." The Office Action admits that Clark shows a **single** ATM. But the Office Action asserts that a "bank usually comprises a plurality of ATMs . . . ." (Office Action, page 8, second paragraph.)

Given that, the Office Action is not relying on Clark to show the claimed "group of ATMs." That "group" has not been shown in the prior art.

Further, claim 8, by its terms, is directed to a "method" of operating a "group of ATMs." Clark, in showing a single ATM, is non-analogous art.



09/651,983  
Art Unit 3628  
9040.00

Claim 8(a) recites:

- a) generating a list of
  - i) ATMs scheduled to be replenished in currency, and
  - ii) the amounts of currency to be replenished in each.

The Office Action admits that Clark does not show the "list." The Office Action asserts that, if a plurality of ATMs need replenishment, then the claimed list would necessarily be created. However, at least two problems exist in this rationale.

#### Problem 1

As stated above, there is no need for an amount-on-a-list required by each ATM. The technician can be given a suitcase full of money, which he uses to fill each ATM. In fact, Clark alludes to such an approach: see column 1, lines 46 - 49.

By analogy, when your car runs low on gas, you do not make an **estimate** of how much gas you need, and then buy that much at a gas station. You simply go to the gas station (the suitcase), and fill up your car.

Therefore, amounts-on-a-list are not necessarily required, contrary to the PTO's assertion.

09/651,983  
Art Unit 3628  
9040.00

Problem 2

The Office Action's rationale is contrary to Clark's teaching, for several reasons.

One reason is that, as explained above, Clark places a magnet on top of a stack of currency. As the currency becomes depleted, the magnet drops in position, and eventually activates a switch. That switch indicates a low level of currency.

It is reasonable to assume that all of the ATMs upon which the PTO relies are of the same Clark-type. Therefore, their switches will all be actuated when currency reaches the same level.

Thus, they will all need the **same amount** of replenishment. There is no reason to make a list for the amount of currency needed for each ATM, as in claim 8(a), because they all need the **same amount**.

A second reason is that Clark states that his technicians arrive at the ATMs with fully loaded cassettes. (Column 6, lines 40 - 42; column 1, lines 52 - 56.) Those replace the existing cassettes. Thus, all ATMs receive the same amounts. There is no need for a list.

Claim 8(b) and (c)

Claim 8(b) and (c) recite:

b) receiving signals from the ATMs which  
indicate that entry into the ATMs has

09/651,983  
Art Unit 3628  
9040.00

occurred;

c) based on the signals, preparing a report which indicates

- i) ATMs scheduled for replenishment;
- ii) ATMs actually replenished; and
- iii) amount of replenishment for each ATM replenished.

The Office Action asserts that Clark, column 6, lines 40 - 53, shows these claim passages, except for claim 8(c)(i), (ii), and (iii). The Office Action asserts that these latter three elements are "obvious."

Again, Applicant points out that "obviousness" is not a substitute for showing claim elements in the prior art. MPEP § 2143.03 states:

To establish prima facie obviousness . . . **all the claim limitations** must be taught or suggested by the prior art.

Further, Applicant points out that claim 8(b) states that the "signals" are received from "ATMs" (plural). The only signals present in Clark are those from a **single** ATM.

Further still, the signals from a **single** ATM cannot be used as in claim 8(c). The signals from that **single** ATM cannot indicate the three types of data [8(c)(i), (ii), and (iii)] for each of **multiple** ATMs.

09/651,983  
Art Unit 3628  
9040.00

Stated another way, at best, the signals of Clark can only indicate information about the ATM which is being replenished, not the rest of the ATMs operated by the bank.

Still further, there is no reason for the **single** ATM which is replenished to issue a report containing 8(c)(i), which lists the ATMs scheduled for replenishment. That ATM would not know the identities of those scheduled ATMs.

And even if the technician knows the scheduled ATMs, why would he add that to the report in Clark ?

Moreover, even if he does report that (but no reason has been given), why would he would do that from every ATM he replenishes ?

Therefore, Applicant submits that the PTO is grafting a procedure onto Clark (namely, that of claim 8(d)(i), (ii), and (iii)) which makes little sense. MPEP § 706.02(j) states:

#### Contents of a 35 U.S.C. 103 Rejection

To establish a prima facie case of obviousness, three basic criteria must be met.

Second, there must be a reasonable expectation of success.

Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The . . . reasonable expectation of success must . . . be found in the prior art and not based on applicant's disclosure.

09/651,983  
Art Unit 3628  
9040.00

As explained above, grafting the report-contents of claim 8(c) onto Clark make no technical sense. There is no reason to report 8(c)(i) from any ATM, let alone all the ATMs which the technician visits.

And it is impossible for the single ATM of Clark to make reports about all other ATMs. The information of claim 8(c) is not available to that ATM.

No reasonable expectation of success has been shown, contrary to this MPEP section.

#### No Teaching Given

No teaching has been given for modifying Clark in the manner done. The modification is to add the report-contents of claim 8(c) to Clark. The rationale given is "to confirm the amount being replenished for inventory and tracking purposes." (Office Action, page 9, top.)

However, Clark already does such confirmation. There is no need to add claim 8(c).

Also, claim 8(c)(i) does not confirm any "amount being replenished," so the rationale does not lead to adding claim 8(c)(i) to Clark.

09/651,983  
Art Unit 3628  
9040.00

#### Additional Point

Finally, claim 8 states that the "report" is generated "based on the signals." **TWO** claim elements are present: (1) the report and (2) the signals. (Under the invention, the "signals" can be burglar-alarm-intrusion-signals, which are interpreted as indicating replenishment, and they induce the "report.")

In Clark, the signals and the report are identical. That is, the technician sends signals which contain the report. There is no distinction between the signals and the report.

The PTO asserts that, since those signals originate from within the ATM, they indicate that somebody entered the ATM, as in claim 8(b).

But the indication is an **inference**. There is no report without the signals, and the signals contain the report. According to the PTO, the presence of the report-signals indicate entry into the ATM, under claim 8(b).

Therefore, two separate claim elements, report and signals, are not present in Clark.

Added claim 11 emphasizes this point.

#### **Added Claims**

Claim 11 states that the report is generated after the signals are received. That is contrary to Clark, wherein, as just explained, the signals contain the report.

09/651,983  
Art Unit 3628  
9040.00

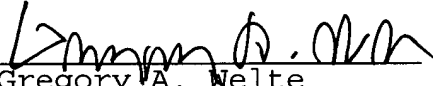
Claim 10 states that the identification is done remotely.  
That is not shown in the applied references.

**Conclusion**

Applicant requests that the rejections to the claims be  
reconsidered and withdrawn.

Applicant expresses thanks to the Examiner for the careful  
consideration given to this case.

Respectfully submitted,

  
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